

***United States Court of Appeals
for the Second Circuit***

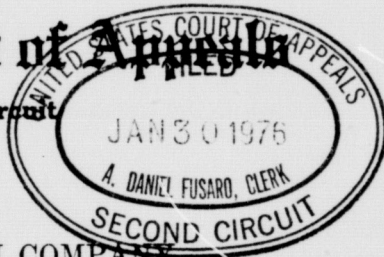


**PETITION FOR
REHEARING**

ORIGINAL **74-2540**

United States Court of Appeals

For the Second Circuit



ABERCROMBIE & FITCH COMPANY,

Plaintiff-Appellant,

v. **!**

HUNTING WORLD, INCORPORATED,

Defendant-Appellee.

**On Appeal from the United States District Court
for the Southern District of New York**

Civil Action No. 70 Civ. 377, Ryan, J.

**PLAINTIFF-APPELLANT'S
PETITION FOR REHEARING**

ROY C. HOPGOOD
HOPGOOD, CALIMAFDE, KALIL, BLAUSTEIN & LIEBERMAN
Attorneys for Plaintiff-Appellant
60 East 42nd Street
New York, New York 10017
(212) 986-2480

PAUL H. BLAUSTEIN
Of Counsel

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PLAINTIFF-APPELLANT'S PETITION FOR REHEARING

Appellant Abercrombie & Fitch respectfully requests rehearing of this Court's Opinion filed January 16, 1976 with respect to the following points:

1. With respect to Registration No. 703,279, must such registration be canceled as to shirts?
2. With respect to shoes only, may the defendant Hunting World continue to use the marks "Hippo Safari" and "Camel Safari" in the United States high-style, affluent market?

I

With respect to our first point on rehearing, this Court stated that as to Registration No. 703,279 only a part had become generic, and in fn. 14 (slip opinion, pages 1579-1580) the part is referred to "the suits, pants, shirts, jackets and hats." We submit that there is nothing in this Court's opinion or in this record as to "Safari" being generic as to shirts. This is an important matter to Abercrombie & Fitch since its shirts carrying the "Safari" label (PX-30) are made of Safari "woven cloth", which is expressly part of Registration No. 703,279 and which is not subject to the order of cancellation. The Safari cloth shirt is shown in PX-31 and PX-37 and reproduced on page 8 of our main brief. The defendant Hunting World had not made shirts which were accused as infringement, and the issue as to shirts was basically not before any of the lower courts or this Court. In its opinion, this Court has noted that with respect to the term "Safari", the hat, the jacket and the jacket when accompanied by pants, may be subject to the generic usage; but there is nothing in the body of this Court's opinion as to shirts. Indeed, there is no reference as to shirts other than in fn. 14. Therefore, we respectfully request that "shirts" be deleted from fn. 14.

II

In our second point on rehearing, we request reconsideration of the holding of fair use as to "Hippo Safari" and "Camel Safari," particularly "Camel Safari." The evidence on this point is entirely documentary, yet considerable differences of opinion have always existed in this case as to the nature of HW's uses of "Hippo Safari" and

"Camel Safari." In the first decision, Judge Lasker said that both parties used these marks in a fanciful sense (see 327 F.Supp. at p. 665 and fn. 7). Judge Ryan disagreed and held that the uses "Camel Safari" and "Hippo Safari" to describe defendant's shoes and boots were purely descriptive, apprising the public of the type of product by referring to its origin and use. This Court relied on Judge Ryan's statement but did not draw any distinction among the various HW uses of "Safari" in connection with shoes. In particular, we point to defendant's use of "Camel Safari" in PX-56 as being "tanned in England," "hand-crafted by skilled European bootmakers," and with "solid brass buckles." It was advertised in these words: "THE LATEST IN ORIGINALITY AND STYLE, created by Robert M. Lee exclusively for Hunting World." The shoe does not come from Africa.* The use is an appeal as to style and, we submit, cannot be a fair use within the statutory terms.

We believe that Judge Lasker's original decision, namely, that as to shoes, particularly "Camel Safari", HW's use was fanciful, accords with the principles set forth in this Court's opinion.

The evidence is entirely documentary. Judge Ryan's interpretation of 15 U.S.C. §1115(b)(4)** is not based on

* Indeed, Mr. Lee testified in pretrial examination that some of the shoes were made by Johnson & Murphy with leather soles, intended for "business wear." (The deposition is in evidence as PX-71, pp. 55-58.)

** 15 U.S.C. §1115(b)(4) reads:

"(b) If the right to use the registered mark has become incontestable under Section 1065 of this title, the registration shall be conclusive evidence of the registrant's exclusive right to use the registered mark in commerce on or in connection with

(footnote continued on next page)

testimony and is primarily a legal interpretation. On this one point, we respectfully submit that this Court's opinion does not provide sufficient guidance for future interpretation of 15 U.S.C. §1115(b)(4) as to the parties.

At least the defendant HW should only be allowed to use the expression "Hippo Safari" and "Camel Safari" in a truly fair use as defined by statute, and in accordance with Judge Ryan's specific language, to wit: in connection with those shoe products which were either (1) intended to be used on safaris or (2) imported from Africa and based on such origins and uses. The defendant HW should not be allowed to use these expressions to appeal clearly to high style by advertising. Since A&F has waived damages, HW cannot be harmed from such clarification.

Respectfully submitted,

ROY C. HOPGOOD
HOPGOOD, CALIMAFDE, KALIL, BLAUSTEIN & LIEBERMAN
Attorneys for Plaintiff-Appellant
60 East 42nd Street
New York, New York 10017
(212) 986-2480

PAUL H. BLAUSTEIN
Of Counsel

the goods or services specified in the affidavit filed under the provisions of said Section 1065 subject to any conditions or limitations stated therein except when one of the following defenses or defects is established:

* * *

"(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a trade or service mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe to users the goods or services of such party, or their geographic origin."

Service of 3 copies of the
within Petition is hereby
admitted this 30th day of

Jan 1976

Signed [Signature]

Attorney for Defendant-Appellee